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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,504	06/18/2002	Subramaniam Ananthan	21381/0053US	7626

7590

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Burton A Amernick  
Connolly Bove Lodge & Hutz  
PO Box 19088  
Washington, DC 20036-0088

EXAMINER

MORRIS, PATRICIA L

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/049,504

Applicant(s)

Ananthan

Examiner

F. Morris

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 12-4-02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-16 is/are pending in the application.
- Of the above claim(s) 2-6 and 12-16 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1 and 7-11 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Pri rity under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachm nt(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing R view, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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### **DETAILED ACTION**

Claims 1 and 7-11 are under consideration in this application.

Claims 2-6 and 12-16 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

#### ***Election/Restriction***

Applicant's election without traverse of Group II in Paper No. 7, filed December 4, 2002 is acknowledged.

This application has been examined with regard to the elected compounds of formula (II) as set forth in claim 1, exclusively.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dondio et al. (WO96/02545).

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Dondio et al. generically embrace the instant compounds. Note, for example, compounds set forth in Scheme 6 wherein R<sub>3</sub> is hydroxy, R<sub>1</sub> is cyclopropylmethyl, R<sub>4</sub> and R<sub>5</sub> together form an oxy group, R<sub>2</sub> is hydroxy, R<sub>5</sub> is hydrogen, R<sub>7</sub> and R<sub>6</sub> are phenyl, hydrogen, hydroxy, alkyl, etc.

It is believed that one having ordinary skill in the art would have found the claimed compounds *prima facie* obvious, since they are generically embraced by the disclosed formula; In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). See also In re Malagari, 499 F.2 1297, 182 USPQ 549 (CCPA 1974); In re Lemin, 332 F.2d 839, 141 USPQ 814 (CCPA 1964); In re Rosicky, 276 F.2d 656, 125 USPQ 341 (CCPA 1960). The requisite motivation for arriving at the claimed compounds stems from the fact that they fall within the generic class of compounds disclosed by Dondio et al. Accordingly, one having ordinary skill in the art would have been motivated to prepare any of the compounds embraced by the disclosed generic formula, including those encompassed by the claims, with the expectation that each of them would be suitable as pharmaceutical agents.

It is believed well settled that a reference may be relied upon for all that it would have reasonably conveyed to one having ordinary skill in the art. In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982); In re Lamberti, 545 F.2d 747, 192 USPQ 278 (CCPA 1976); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); In re Susi, *supra*.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The plural 's' on "salts" makes claim 1 read on mixtures rather than specific compounds. Further, the expression "and pharmaceutically .....salts" in claim 1 is improper Markush language and needs to be written in alternative language. It is suggested it be changed to "or pharmaceutically .....salt thereof."

The claims measure the invention. United Carbon Co. V. Binney & Smith Co., 55 USPQ 381 at 384, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

The U.S. Court of Claims held to this standard in Lockheed Aircraft Corp. v. United States, 193 USPQ 449, "Claims measure invention and resolution of invention must be based on what is claimed".

The C.C.P.A. in 1978 held "that invention is the subject matter defined by the claims submitted by the applicant. We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim": In re Priest, 199 USPQ 11, at 15.

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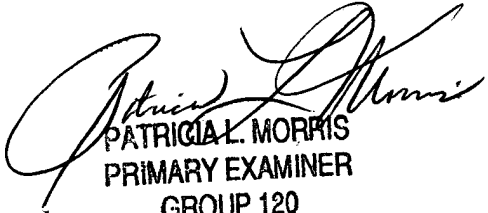
***Specification***

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533. The examiner can normally be reached Mondays through Fridays.

  
PATRICIA L. MORRIS  
PRIMARY EXAMINER  
GROUP 120

plm

January 16, 2003